



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/656,553 | 09/06/2003 | Oscar D. Sandlin | | 8187 |

7590 04/25/2005

Bryan S. Redding
Suite 800
8888 Keystone Crossing Blvd.
Indianapolis, IN 46240

EXAMINER

COSTALES, SHRUTI S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1714

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

15

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/656,553 | SANDLIN ET AL. | |
| | Examiner | Art Unit | |
| | Shruti S. Costales | 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/6/03</u> . | 6) <input type="checkbox"/> Other: _____ |

A

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on September 6, 2003 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement filed by the applicant has been considered by the Examiner.

Specification

2. The abstract of the disclosure is objected to because the applicant uses legal phraseology such as "present invention discloses". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the

Art Unit: 1714

abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A method of making a long-lasting scented paint mixture having a pigment, a binder, a solvent, a suitable vehicle, and a scenting agent".

Claim Objections

4. Claims 1, 7, and 12 are objected to because each of these claims fail to include an "and" at the end of the steps preceding each of the last steps of the claims. For example, in claim 1 an "and" should be inserted at the end of step "e)" signifying that step "f)" will be the last step in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-6, 8-9, and 11 recite the limitation "the other elements" or "the elements noted". However, there is insufficient antecedent basis for these limitations in the cited claims as "elements" is not introduced preceding the recitation of "the other elements" or "the elements noted". It is not clear to one skilled in the art which "other elements" the applicant is referring to. Appropriate correction is required.

7. Regarding claims 19-21, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following said phrase are part of the claimed invention. See MPEP § 2173.05(d). Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1714

9. Claims 1-11, 13-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (U.S. Patent Number 6,706,107), hereinafter referred to as Walker, in view of the evidence set forth by Immordino, JR. et al. (U.S. Pre-Grant Publication Number 2002/0129744), hereinafter referred to as Immordino.

It is disclosed that a non-toxic paint composition includes providing a vehicle, a kaolin slurry having water as a solvent, a pigment dispersion, and other additives including fragrances such as cinnamon, and wax (Col. 2, lines 62-67; Col. 4, lines 62-65; and Col. 5, lines 1-11). These components within the paint composition are mixed together in *any order* suitable for making a homogeneous non-toxic paint composition [*emphasis added*] (Col. 5, lines 12-20) corresponding to the various orders of mixing the components of the paint composition as claimed in the cited claims. It is to be noted that the use of wax as disclosed by Walker as a component of the paint composition is for the purpose of obtaining a desired texture or appearance (Col. 5, lines 10-11).

Further, Immordino sets forth the fact that certain waxes act as an internal binder within a joint compound composition while improving paint gloss retention (Abstract of Immordino), therefore it inherently follows that the wax disclosed in Walker functions as a binder as well. It is to be noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In light of the above discussion, it is clear that the presently cited claims are anticipated.

10. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Maleeny et al. (U.S. Pre-Grant Publication Number 2003/0232901), hereinafter referred to as Maleeny, in view of the evidence set forth by Takarabe et al. (U.S. Patent Number 5,705,560), hereinafter referred to as Takarabe.

Maleeny discloses a method of making a scented paint composition by incorporating paint scenting additives and a paint scenting mixture into *any typical paint* composition containing a pigment suspended in a liquid medium, wherein the paint scenting mixture includes a fragrance material in an amount sufficient to at least reduce malodors in an ambient surrounding in which the paint is applied as well as to provide a long-lasting pleasant aroma in such surroundings [*emphasis added*] (Page 5, paragraph [0051]). Maleeny does not expressly disclose the various well-known components of any typical paint. However, Takarabe discloses that *ordinary paint* components include pigment, binder, vehicle, solvent, and several other additives corresponding to the presently cited claims [*emphasis added*] (Col. 10, lines 39-45 of Takarabe). In fact, applicant discloses at page 6 of the specification that the above listed components of paint are well known to those skilled in the art.

In view of the above discussion, it is clear that the presently cited claims are anticipated.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Maleeny.

The discussion above regarding Walker and Maleeny in paragraphs 9 and 10 is incorporated herein by reference.

Walker discloses a non-toxic paint composition having a fragrance but does not expressly disclose that the fragrance is long-lasting. Maleeny, however, discloses adding paint scenting mixtures having a high level of fragrance such that sufficient aroma is imparted to the ambient surroundings when the paint is applied resulting in long lasting pleasant aroma in the surroundings (Page 2, paragraphs [0013] and [0020]; Page 3, paragraph [0031]). It would have been obvious to one skilled in the art to

Art Unit: 1714

combine the paint composition of Walker with Maleeny's aroma imparting scenting mixtures having high levels of fragrance to obtain a scented paint composition providing a long-lasting scent to obtain the invention as set forth in the presently cited claims.

13. Claims 1-11, 13-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Takarabe and Walker.

The discussion above regarding Walker, Maleeny, and Takarabe in paragraphs 9 and 10 is incorporated herein by reference.

Maleeny discloses a method of making a long-lasting scented paint composition by incorporating paint scenting additives and a paint scenting mixture into any typical paint composition containing a pigment suspended in a liquid medium (Page 5, paragraph [0051]). Although Maleeny does not explicitly disclose the various components of paint, Takarabe discloses that ordinary paint components include pigment, binder, vehicle, solvent, and several other additives (Col. 10, lines 39-45 of Takarabe).

It would have been obvious to one skilled in the art to use the various well-known components of paint as described in Takarabe thereby producing *any typical paint* composition capable of incorporating the paint scenting mixture of Maleeny because ordinary paint includes the various components listed above (Col. 10, lines 39-45 of Takarabe) thereby obtaining the invention as set forth in the presently cited claims.

Further, although Maleeny does not explicitly disclose the addition and mixing various paint components such as pigment, binder, vehicle, solvent, and the paint

Art Unit: 1714

scenting mixture in any order, Walker discloses that various paint components including fragrances such as cinnamon in a paint composition are mixed together in *any order* suitable [*emphasis added*] (Col. 5, lines 12-20 of Walker). It would have been obvious to one skilled in the art to combine the paint components of Maleeny in any suitable order so as to result in a homogeneous paint composition (Col. 5, lines 12-20 of Walker) thereby obtaining the invention as set forth in the presently cited claims.

14. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Engle (U.S. Patent Number 4,095,031).

The discussion above regarding Walker in paragraph 9 is incorporated herein by reference.

Maleeny discloses a method of making a long-lasting scented paint composition and applying the long-lasting scented paint composition. Although Maleeny does not explicitly disclose the application of an unscented paint and then applying a scenting agent onto a wet surface, Engle discloses applying perfume oils onto a wet surface of a shaped resin body (Col. 1, lines 38-42) which may be employed as a coating on a substrate (Col. 2, lines 50-51). Given that Engle further discloses adding perfume oil to a wet surface in order to obtain a uniform blend (Col. 1, lines 38-42 and Col. 2, lines 10-12), which serves as a coating on a substrate (Col. 2, lines 50-52) it would therefore have been obvious to do so with Maleeny's composition thereby obtaining the invention as set forth in the presently cited claims.

Art Unit: 1714

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maleeny in view of Engle and Walker.

The discussion above regarding Walker, Maleeny, and Engle in paragraphs 9, 10, and 14 is incorporated herein by reference.

Maleeny discloses a method of making a long-lasting scented paint composition by incorporating paint scenting additives and a paint scenting mixture into any typical paint composition (Page 5, paragraph [0051]) wherein Maleeny in view of Engle discloses that a scenting agent may be applied onto a set surface. Although Maleeny and Engle do not explicitly disclose that the scenting agent is cinnamon, Walker discloses that a scenting agent such as cinnamon may be incorporated into a paint composition (Col. 2, lines 62-67; Col. 4, lines 62-65; and Col. 5, lines 1-11). It would have been obvious to one skilled in the art to combine the cinnamon scenting agent of Walker into the paint composition of Maleeny in order to combat any unpleasant odors (Col. 4, lines 62-67) thereby obtaining the invention as set forth in the presently cited claim.

16. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Maleeny, Engle, and Sokol (U.S. Patent Number 6,583,195).

The discussion above regarding Walker, Maleeny, and Engle in paragraphs 9, 10, and 14 is incorporated herein by reference.

Walker and Maleeny disclose scented paint compositions and methods of making said scented paint compositions. Maleeny and Engle disclose applying a

Art Unit: 1714

scenting agent onto a wet surface. Although Walker and Maleeny do not explicitly disclose incorporating a scenting agent having insect repellent qualities such as citronella into said paint compositions, Sokol discloses adding natural or synthetic insect repellents such as citronella or cedarwood oil (scent) to coating compositions such as paints (Col. 1, lines 62-67; Col. 2, lines 1-4; and Col. 6, lines 22-24). It would have been obvious to one skilled in the art to use insect repellents such as citronella in Walker and Maleeny's paint compositions to repel animals from eating or living in on treated structures (Col. 6, lines 25-28) thereby obtaining the invention as set forth in the presently cited claims.

17. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Donovan (U.S. Patent Number 5,217,378).

The discussion above regarding Walker in paragraph 9 is incorporated herein by reference.

Walker discloses a fragranced non-toxic paint composition but does not expressly disclose that the fragrance may be used by the visually impaired to identify various colors of paint by fragrance. Donovan, however, discloses a painting kit for the visually impaired wherein each bottle of paint identifiable by scent (Col. 1, lines 6-10). It would have been obvious to one skilled in the art to use Donovan's technique of identifying various colors of paint by scent while using the paint composition disclosed by Walker in order to provide the visually impaired a means to identify various paint colors thereby increasing sensory input and increasing the levels of learning of the

Art Unit: 1714

visually impaired (Col. 2, lines 43-47), to obtain the invention as set forth in the presently cited claims.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Youtsey et al. (U.S. Patent Number 3,992,212) discloses an ink composition, wherein "ink" includes paint, having a binder, vehicle, solvent, pigments, and perfumes. Durocher et al. (U.S. Pre-Grant Publication Number 2004/0177786) discloses a scented paint and surface protectant composition imparting long-lasting fragrance.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Shruti S. Costales
April 15, 2005

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700